



PATENT *APR 29*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Inventor: Nikolaos Papadopoulos

Application No.: 09/485,679

Confirmation No: 4514

Filed: June 19, 2000

Attorney No.: PAPA3001/JEK/JJC

Customer No.: 23364

Examiner: Sheila B. Smith

Art Unit: 2681

For: MOBILE RADIO TELEPHONE SYSTEM HAVING AN IDENTITY WHICH
CAN BE DYNAMICALLY CHANGED

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal brief is filed pursuant to the appellants' appeal to the Board of Patent Appeals and Interferences from the final rejection of the claims in the above-application.

I. REAL PARTY OF INTEREST

The real party in interest is the assignee of record: Giesecke & Devrient GmbH (Munich, GERMANY).

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-13, 15 and 16 are currently pending in the above-referenced application and each claim presently stands rejected.

Claim 14 is canceled.

Applicants appeal from the rejection of claims 1, 2, 6 and 13. Claims 3-5 and 9 depend from claim 1. Claims 7, 8 and 10-12 depend from claim 2. Claims 15 and 16 depend from claim 13. A copy of appealed claims 1, 2, 6 and 13 are included in the attached Appendix I.

IV. STATUS OF AMENDMENTS

An amendment was filed concurrently with this appeal brief on November 29, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In each of the appealed claims, systems or methods are generally provided for improving known mobile radio systems, for example in a global system for mobile communication (GSM) network (page 1, lines 7-8; page 4, lines 19-21). In particular, the claims are directed to improvements of mobile terminals (ME) (i.e., mobile phones) (page 1, lines 17-19) that are controlled by subscriber identity modules (SIM) (page 1, lines 9-11; page 4, lines 26-29; FIG. 2). The subscriber identity modules (SIM) are used for granting an authorized person access to the mobile radio system and storing an international mobile subscriber identity (IMSI) (page 1, lines 13-14; page 4, lines 26-27; FIG. 2). The subscriber identity is used for identifying a subscriber and a subscription to the mobile radio system (page 1, lines 14-15).

Each of the appealed claims recites an improvement over known mobile radio systems (page 2, lines 1-3, 18-23). In this improvement, the subscriber identity module (SIM) contains a calculation rule RV that calculates and generates from the subscriber identity (IMSI) at least one new additional identity (IMSI_w) (page 5, lines 3-7, 14-16; FIG. 2, 3).

The additional identity (IMSI_w) in combination with the identity (IMSI) provides a more flexible subscriber identity module (SIM) since it is only necessary to provide the subscriber identity module (SIM) with one identity (IMSI) at its issue to a user (page 2,

lines 18-21). Moreover, an owner of the mobile terminal may obtain an additional identity (IMSI_w) that is created at a later time without requiring a new subscriber identity module (SIM). Thus, an owner may have an identity for personal use and an identity for business use across the mobile network using the same mobile terminal (ME) (page 6, lines 26-30; FIG. 5).

Claims 1 and 2 recite additional features relating to a mobile radio system that employs an improvement of the invention. Claims 1 and 2 each specifically recite a mobile radio system having a plurality of mobile terminals (ME) that are connected via an air interface for communication control and billing to a mobile switching center (MZ) (page 4, lines 19-21; FIG. 1).

Claim 1 further describes that when the new identities (IMSI_w) are created, they are recognized and transmitted to the mobile switching center (MZ) by a subscriber identification module (SIM) (page 2, lines 11-13; FIG. 1).

On the other hand, claim 2 specifies that the subscriber identity module (SIM) is configured to generate a request signal to the mobile switching center (MZ) for creating a new identity (IMSI_w) (page 2, lines 12-16). Upon receiving a response from the subscriber identity module (SIM), the mobile switching center (MZ) sends a new additional identity (IMSI_w) to the subscriber identity module (SIM) which is stored thereon.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 6, 7, 8, 11, 12 and 13 finally stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 5,854,976 (Garcia Aguilera et al. referred herein as "Garcia").

A copy of the Garcia-Aguilera et al. patent is included in the attached Appendix II, and a copy of the final rejection dated July 19, 2004 is attached as Appendix III.

VII. ARGUMENT

A. Overview

The Garcia patent fails to disclose or suggest each and every feature, whether expressly or inherently, recited in claims 1, 2, 6 and 13 of the pending application.

Moreover, one skilled in the art would not reasonably understand or infer from the Garcia patent each of the limitations of claims 1, 2, 6 and 13.

Accordingly, the Garcia patent does not render obvious claims 1, 2, 6 and 13 of the pending application.

Due to the similarity in subject matter of claims 1, 6 and 13, in which inventive feature of the subscriber identity module (SIM) having a calculation rule for creating a new additional identity (IMSI_w) from an identity (IMSI) stored on the subscriber identity module (SIM) is positively recited, the following arguments for the patentability of claims 1, 6 and 13 in view of the Garcia patent will be treated together.

While mostly having the same features, claim 2 is discussed separately from the arguments for the patentability of claims 1, 6 and 13.

B. Pertinent Law

To establish obviousness under 35 U.S.C. § 103(a), differences between the subject matter sought to be patented and the prior art reference are such that the subject matter as a whole would have been obvious to one skilled in the art at the time of the invention. Accordingly, in making an assessment of differences, section 103 specifically requires consideration of the claimed invention as a whole guided by the accepted wisdom at the time the invention was made. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d (BNA) 1686, 1689 (Fed. Cir. 2004).

Identification of each element of a claimed invention in prior art references is insufficient to defeat patentability of the whole claimed invention. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d (BNA) 1453, 1457 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching to select and combine the references relied on as evidence of obviousness. *In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d (BNA) 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001 (BNA), 1008 (Fed. Cir. 2001)).

In making a rejection based on obviousness, particular findings and specific reasons must be provided as to why a skilled artisan would have been motivated to select references and to combine them to render a claimed invention obvious. See *In re*

Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313, 1317 (Fed. Cir. 2000); See also *In re Rouffet*, 149 F.3d at 1359, 47 U.S.P.Q.2d (BNA) at 1459 (Fed. Cir. 1998).

Evidence of the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d (BNA) 1614, 1617 (Fed. Cir. 1999). Whether an express or implicit showing is relied upon, particular findings related thereto must be provided therewith. *Id.* When general knowledge is relied upon to negate patentability, that knowledge must be articulated in the record and cannot be resolved on “subjective belief and unknown authority.” *Lee*, 277 F.3d at 1342-1345, 61 U.S.P.Q.2d (BNA) at 1433-35.

C. Basic Description of the Garcia Patent

The Garcia Patent describes a method for subscriber identity authentication in fixed cellular terminals (TCF) by using an initial subscriber identification number stored therein for activating the fixed terminal (TCF) (column 2, lines 25-30). When initializing the fixed terminal (TCF), the initial subscriber identification number is transmitted to a subscriber identity module (SIM) to determine if it corresponds to a stored identification number in the subscriber identity module (SIM) (column 2, lines 31-36). After initializing the fixed terminal (TCF), the fixed terminal (TCF) generates a new subscriber identification number that replaces the initial subscriber identification number and is secret from the user of the fixed terminal (TCF) (column 2, lines 37-42; column 4, lines 38-42, lines 49-61).

The method according to the Garcia patent is specifically directed to fixed cellular terminals (TCF) and activation thereof (column 3, lines 14-16; FIG. 1).

The fixed terminal (TCF) forms part of a mobile cellular communications network, such as a GSM network (column 3, lines 19-23), that is formed by a mobile switching center (CCM) that permits access to a wired network and a plurality of base stations (BS) (column 3, lines 8-11; FIG. 1). Each base station (BS) provides coverage for a predetermined zone in which there are cellular mobile terminals (TCM) and fixed cellular terminals (TCF) (column 3, lines 12-13; FIG. 1). The fixed terminals offer a standard access interface to the wired network (RF) for a set of fixed subscriber terminals (U) (column 3, lines 17-18; FIG. 1).

The fixed terminal (TCF) requires entry of the initial subscriber identity number in order to initialize the fixed terminal (TCF) (column 3, lines 61-67), and moreover requires use of the new subscriber identity number each time the fixed terminal (TCF) is in operation (column 4, lines 38-48).

D. The Subject Matter Recited in Claims 1, 6 and 13 is Not Obvious in View of the Garcia Patent

In the discussion that follows, the appellants submit that the mobile radio system of claim 1 and the methods of claims 6 and 13 of the pending application, respectively, differ from the teachings of the Garcia patent on the basis of the following particulars:

a) the Garcia patent fails to disclose or suggest the use of an identity (IMSI) for a mobile communications network;

b) the Garcia patent fails to disclose or suggest the creation of a new, additional identity (IMSI_w) from an initial identity (IMSI) and the combined use thereof; and

c) the Garcia patent fails to disclose or suggest a subscriber identity module (SIM) of mobile terminal having a calculating rule for creating a new, additional identity (IMSI_w) from an initial identity (IMSI) stored on the subscriber identity module (SIM).

Moreover, it is respectfully submitted that the proposed reconstruction of the fixed terminal (TCF) of the Garcia patent is an impermissible hindsight rejection that finds no basis in the Garcia patent.

1. The Garcia patent fails to disclose or suggest the use of an identity (IMSI) for a mobile communications network

A subscriber identification number for providing access to a subscriber identity module (SIM) is not an equivalent, whether explicitly or implicitly, to an identity (IMSI) of a mobile communications network, as recited in claims 1, 6 and 13 of the pending application. As is well understood in the art of mobile communications, an identity (IMSI) is provided for identifying a user across a network and conveying additional security and pertinent information of the user. On the contrary, the subscriber identity number of the Garcia patent is akin to a personal identification number (PIN) that is merely inputted into a device to obtain access of a device.

The Garcia patent describes the subscriber identification number as authenticating a subscriber identity so as to permit access to all of the functions of subscriber information module (column 3, lines 41-47). There is no description or suggestion of this subscriber information module being used to identify a subscriber across a network.

The difference between the subscriber identification number of the Garcia patent and the identity (IMSI) of the pending claims is likened to a key and a tag, respectively, in that they differ in function and scope. The subscriber identification number acts as a key with opens access to functions of a fixed terminal TCF. The subscriber identification number is valid for only one fixed terminal TCF, and like a key for only one lock, and it is not globally useable across a network. On the other hand, the identity (IMSI) recited in the claims serves as a tag that denotes a particular user and information pertinent therefore. Unlike the subscriber information number according to the Garcia patent that is only valid for a particular fixed terminal (TCF), the identity (IMSI) is globally recognizable across the network.

Hence, the subscriber identification number of the Garcia patent and the identity (IMSI) are not equivalent in either function or scope, as asserted in the final rejection of claims 1, 6 and 13.

The final rejection is premised on the erroneous correlation of a subscriber identification number with an identity (IMSI), and baldly ignores the inherent differences between such features in a communications network. The final rejection fails to consider the Garcia patent as a whole and the specific description of the subscriber identification number. It is asserted that the Garcia patent fails to disclose or suggest the use of identities (IMSI) as would be clearly understood by one of ordinary skill in the art of mobile communication networks. Moreover, the final rejection fails to proffer a teaching in the Garcia patent that equates a subscriber identification number to an identity (IMSI).

Thus, the Garcia patent fails to disclose or suggest the use of an identity (IMSI) for a mobile communications network recited in claims 1, 6 and 13.

2. The Garcia patent fails to disclose or suggest the creation of a new, additional identity (IMSI_w) from an initial identity (IMSI) and the combined use thereof

The teaching of a generation of a new subscriber identification number from an initial subscriber identification number and the replacement of the initial number with the new number does not correspond to the creation of a new, additional identity (IMSI_w) from an initial identity (IMSI). According to the Garcia patent, it is specifically taught that the new number replaces the initial number (column 4, lines 38-42) and this new number is maintained in secret to all parties (column 4, lines 58-61). Hence, the newly generated identification number of the Garcia patent is not used in addition to the initial number.

In view of the previous discussion, there is simply no disclosure or suggestion of creating a new identity that is used in conjunction with an initial identity. This difference between claims 1, 6 and 13 and the Garcia patent is particularly evident in view of the different nature of the identity (IMSI) and additional identity (IMSI_w) of the pending claims from the subscriber identification number of the Garcia patent. More specifically, the additional identity (IMSI_w) in combination with the identity (IMSI) of the pending application enables a user to have multiple identities that extend across a mobile network. Contrariwise, the new number in the Garcia patent prevents use of the subscriber identity module (SIM) outside a respective fixed terminal (TCF) since it is necessary to insert the new number in order to enable another fixed terminal (TCF). Since this new number is secret, no parties are able to insert such new number (column 4, lines 58-61).

Once again, it is readily evident that a subscriber identification number is starkly different from an identity (IMSI) and an additional identity (IMSI_w). The final rejection fails to consider these contrary teachings in the Garcia patent and it is readily apparent that the final rejection does not treat the Garcia patent as a whole. It is submitted that one of ordinary skill in the art would not be motivated by the teachings of the Garcia patent to create a new additional identity (IMSI_w) from an identity (IMSI), and using both the new additional identity (IMSI_w) and an identity (IMSI) across a mobile communication network. Moreover, the final rejection fails to provide any evidence in

the Garcia patent to support the allegation that the replacement of a subscriber identification number is the same as creating a new additional identity (IMSI_w) from an identity (IMSI).

Therefore, the Garcia patent fails to disclose or suggest the creation of a new, additional identity (IMSI_w) from an initial identity (IMSI), and the combined use thereof.

3. The Garcia patent fails to disclose or suggest a subscriber identity module (SIM) of mobile terminal (ME) having a calculating rule

Unlike in pending claims 1, 6 and 13 wherein a mobile terminal (ME) includes a subscriber identity module (SIM) having a calculating rule (RV), the Garcia patent describes a fixed terminal (TCF) as having calculating means which transmit a new replacement subscriber identification number to a subscriber identification module (SIM). The final rejection simply fails to consider this inconspicuous difference.

As distinguished in the Garcia patent itself, it is clear that the procedure for authentication is only directed to fixed terminals (TCF) which are delineated from cellular mobile terminals (TCM) (column 3, lines 12-18). While the final rejection attempts to argue that fixed terminals (TCF) are interchangeable with mobile terminals, it fails to compensate for the stark difference between fixed and mobile terminals which the Garcia patent itself distinguishes. For example, the Garcia patent indicates that fixed cellular terminals have “their own design since they are not equipped with the proper mobility functions (handover, roaming, etc.) for which they have no need” (column 1, lines 23-25).

A problem that the teachings of the Garcia patent attempts to solve is that the procedure for authentication seeks to remove the risk of the removal of a subscriber information module (SIM) from a fixed terminal and the insertion of the module (SIM) into a mobile terminal (column 2, lines 4-14). According to the Garcia patent, it is the fixed terminal (TCF), therefore, that has calculation means. Thus, by replacing an initial subscriber identification number with a new, secret number, the subscriber information module (SIM) can only be used with a respective fixed terminal (TCF) upon which the calculation means is stored.

On the contrary, by providing a calculation rule on a subscriber information module (SIM), the module (SIM) can be used across a mobile communications network and is thus interchangeable with other mobile terminals.

In view of these observations, the Garcia patent fails to disclose or suggest a subscriber identity module (SIM) of mobile terminal (ME) having a calculating rule for calculating a new, additional identity (IMSI_w) for use across a mobile communications network. In fact, the Garcia patent clearly describes a contrary arrangement without any evidence contained therein that tends to suggest any deviation therefrom. It is thus submitted that one of ordinary skill in the art would not be motivated by the teachings of the Garcia patent to provide a subscriber identity module (SIM) of mobile terminal (ME) with a calculating rule according to claims 1, 6 and 13 of the pending application.

4. The reconstruction the features in the teachings of the Garcia patent is an impermissible hindsight reconstruction

As detailed above, the Garcia patent neither discloses nor suggests the function and scope of the features of pending claims 1, 6 and 13. Accordingly, there is no evidence of motivation to reconstruct the teachings of the Garcia patent in the manner prescribed in the final rejection to make the mobile radio system of pending claim 1 and the methods of pending claims 6 and 13 of the present application.

While the Examiner selects the fixed terminal (TCF) of the Garcia patent as a mobile terminal (ME) according to the pending application, the rejection appears to ignore that the Garcia patent itself distinguishes a fixed terminal (TCF) from a mobile terminal (ME). Moreover, the authentication process of the Garcia patent is clearly described as only pertaining to a fixed terminal and the access thereof. The authentication process is thus restricted to a particular fixed terminal (TCF) and is not intended for use across an entire network. Once again, the final rejection omits this relevant teaching of the Garcia patent in erroneously correlating a fixed terminal to a mobile terminal.

In view of the teachings of the Garcia patent, it follows that reconstructing a subscriber identification module (SIM) with a calculation rule would teach away from the express teachings of the Garcia patent wherein it is the fixed terminal itself that has a calculation means.

Another glaring deficiency in the final rejection is the substitution of the subscriber identification number of the Garcia patent with an identity (IMSI). Despite the fact that the subscriber identification number of the Garcia patent is restricted to a particular fixed terminal, the final rejection assumes that the subscriber identification number is the same as an identity (IMSI) that is used across a network. This assumption is incorrect and the differences between these features in a mobile communications network would be readily obvious to one of ordinary skill in the art.

In view of the observations on the deficiencies of the final rejection and the interpretation of the Garcia patent, the final rejection proposes a hindsight modification of the Garcia patent that makes no sense and will not work. To base a rejection on assumptions which have no basis in the reference itself is clearly an improper hindsight rejection. As is well understood, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, U.S.P.Q. (BNA) 1596, 1600 (Fed. Cir. 1988). The proposed reconstruction of the teachings of the Garcia patent amounts to a hindsight reconstruction of the very type prohibited by the courts wherein the rejection is effectively based on the disclosure of the pending application.

The final rejection asserts that in view of the teachings of the Garcia patent, one of ordinary skill in the art would have been motivated to make or devise the mobile radio system and methods of the pending claims. The rationale for the motivation proffered by the final rejection is that it would have been routine skill in the art to modify the teachings of the Garcia patent.

The rationale of the final rejection does not find any support in the Garcia patent and, as detailed above, is based on erroneous assumptions. The final rejection has failed to consider and comprehend the teachings of the Garcia patent as a whole, including portions that lead away from the claimed invention. Indeed, the Garcia patent provides contrary teachings to the system and methods described in the claims, and falls short of providing any evidence that would tend support the notion that teachings of the Garcia patent could be construed to devise the system and methods of the pending claims. The statements regarding the motivation or desirability to modify the teachings of the Garcia patent are grounded on subjective belief and unknown authority. Thus,

the final rejection has failed to make the requisite findings of motivation to modify the authentication process of the Garcia patent in the manner of the pending claims and, moreover, has failed to explain the reasoning by which the findings are deemed to support the conclusions therein. See e.g., *Lee*, 277 F.3d at 1345, 61 U.S.P.Q. at 1434.

It is therefore submitted that the substantial reconstruction of the Garcia patent and the failure to consider the Garcia patent as a whole results in an improper hindsight rejection. Thus, the motivation provided by the final rejection to modify the teachings of the Garcia patent appear to be taken from Appellants' own disclosure or are merely based on an overall misunderstanding of the Garcia patent.

E. The Subject Matter Recited in Claim 2 is Not Obvious in View of the Garcia Patent

The Garcia patent does not disclose or suggest a mobile switching center that creates a new, additional identity (IMSI_w) and communicates with a subscriber identity module (SIM) the new, additional identity (IMSI_w) for a mobile radio system. The final rejection of claim 2 simply fails to address the inventive features of claim 2 and summarily dismisses this subject matter by using the same basis that is used for the rejection of claims 1, 6 and 13.

It is readily apparent in view of the discussion above regarding the teachings of the Garcia patent directed to fixed cellular terminals (TCF) and the generation of a newly subscriber information number for a specific cellular terminal, that the Garcia patent describes a method that is non-analogous to the inventive features of claim 2 of the pending application. In fact, the Garcia patent clearly indicates that it is the fixed terminal that has calculation means which generate a new subscriber information number. There is simply no evidence provided in the teachings of the Garcia patent or evidence proffered by the final rejection which would tend to motivate one of ordinary skill to devise a mobile radio system according to claim 2.

Accordingly, it is submitted that the Garcia patent does not render obvious the mobile radio system according to claim 2.

VIII. CONCLUSION

For the reasons set forth above, appended claims 1, 2, 6 and 13 of the pending application define subject matter that is not anticipated within the meaning of 35 U.S.C. § 103(a) over the Garcia patent.

The fee required by 37 C.F.R. § 1.17(c) is enclosed herewith.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500

Date: November 29, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

JUSTIN J. CASSELL
Attorney for Applicants
Registration No. 46,205



APPENDIX I

LIST OF APPEALED CLAIMS

1. A mobile radio system having a plurality of mobile terminals (ME) connected with a mobile switching center (MZ) via an air interface for communication control and optionally for billing, the mobile terminals (ME) being controlled by a subscriber identity module (SIM) in which data for associating at least one user are stored, the subscriber identity module (SIM) having an identity (IMSI) associated therewith, wherein the subscriber identity module (SIM) contains a calculation rule for calculating and generating from the stored identity (IMSI) at least one new identity (IMSI_w), the new identities created by the calculation rule being associated accordingly in the mobile switching center (MZ).

2. A mobile radio system having a plurality of mobile terminals (ME) connected with a mobile switching center (MZ) via an air interface for communication control and optionally for billing, the mobile terminals (ME) being controlled by a subscriber identity module (SIM) in which data for associating at least one user are stored, the subscriber identity module (SIM) having an identity (IMSI) associated therewith, wherein the subscriber identity module (SIM) is configured to generate a request signal and in response to the request signal the mobile switching center (MZ) communicates a newly created identity (IMSI_w) associated with the subscriber identity module (SIM).

6. A method for operating mobile terminals (ME) of a mobile radio system which are controlled by a subscriber identity module suitable for operation with at least two identities, wherein the new identities are created by a calculation rule from a single identity (IMSI) stored in the subscriber identity module (SIM).

13. A subscriber identity module (SIM) for a mobile terminal (ME) in a mobile radio system in which an identity (IMSI) for a user is stored, wherein a calculation rule is stored in the subscriber identity module (SIM) for calculating from the stored identity (IMSI) at least one newly created identity (IMSI_w).



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,679	06/19/2000	NIKOLAOS PAPADOPOULOS	JEK/PAPADOPO	4514

23364 7590 07/19/2004

BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

PAPA3001

EXAMINER

SMITH, SHEILA B

ART UNIT	PAPER NUMBER
----------	--------------

2681

Date 7-20-04 Atty JEK/JJC

Action Due Final Resp

Deadline 10-19-04

Final Deadline 1-19-05

Based on _____

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.





Office Action Summary

Application No.

09/485,679

Applicant(s)

PAPADOPOULOS ET AL.

Examiner

Sheila B. Smith

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims ^{1, 2, 6, 7, 8, 11, 12, 13} ~~1-16~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia Aguilera et al. (U. S Patent Number 5,854,976).

Regarding claims 1, 2, 6, 7, 8, 11, 12, 13, Garcia Aguilera et al. discloses essentially all the claimed invention as set forth in the instant application, further Garcia Aguilera et al. discloses subscriber identity authentication in fixed cellular terminals. In addition Garcia Aguilera et al. discloses a mobile system having mobile terminals (TCF) connected to a mobile switching center (CCM) via an air interface for communication control and optionally for billing (which reads on column 3, lines 7-18), the mobile terminals being controlled by a SIM in which data for associating at least one user are stored (which reads on column 3, lines 61-67), the SIM having an IMSI associated with it (reads on "the cellular technology employed in this implementation uses the European standard GSM (Global System for Mobile), developed by the ETSI (European Telecommunications Standards Institute), for standardization of digital cellular mobile telephony on an European level" which is used for identifying the user in a global system as disclosed in column 3, lines 19-23). However Garcia Aguilera et al. fails to specifically disclose wherein the SIM contains a calculation rule for calculating and generating

from the stored identity at least one new identity the new identities created by the calculation rule being associated accordingly in the mobile switching center.

Garcia Aguilera et al. discloses the claimed invention except for “to generate the new subscriber identification number, the fixed cellular terminal TCF performs a series of arithmetical functions, such as those described below by way of example: The fixed cellular terminal TCF takes as input data the subscriber identification number that it has stored in the EEPROM. Following this, it determines the number of digits that constitute this number, and which can vary between four and eight digits. Depending on the result, it adds a number of zeros until an eight-digit number is obtained. Finally the fixed cellular terminal TCF inverts the odd and even positions of this last number and thereby produces the new subscriber identification number” as disclosed in column 4 lines 22-34. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the SIM contains a calculation rule for calculating and generating from the stored identity at least one new identity the new identities created by the calculation rule being associated accordingly in the mobile switching center, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

2. Claims 3-5,9,10 and 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia Aguilera et al. in view of Julin (U. S Patent Number 6,212,372).

Regarding claims 3-5,9,10, Garcia Aguilera et al. discloses everything claimed, as applied above (see claim 1) however Garcia Aguilera et al. fails to specifically disclose, the new identity is affected by a user entry via a keyboard.

In the same field of endeavor Julin discloses method in mobile telephone systems in which a subscriber identity module (SIM) is allocated at least two identities, which are selectively activated by the user. In addition Julin discloses “the selective identity activation, i.e. the selection of identity function in the subscriber identity module, can be carried out with the aid of keys or the like provided on the subscriber unit, or with the aid of special means provided on the subscriber identity module” which reads on the new identity is affected by a user entry via a keyboard as disclosed in column 2 lines 17-23.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Garcia Aguilera et al. with the new identity is affected by a user entry via a keyboard as taught by Julin for the purpose of subscriber identity selection.

Regarding claims 15-16, Garcia Aguilera et al. discloses everything claimed, as applied above (see claim 1) however Garcia Aguilera et al. fails to specifically discloses method in mobile telephone systems in which a subscriber identity module (SIM) contains a temporary memory area for temporarily storing a further identity which is calculated or communicated by the mobile switching center.

Garcia Aguilera et al. discloses the claimed invention except for “the fixed cellular terminal TCF generates a new subscriber identification number, it being recorded in a buffer memory of the low frequency signals and control module BFC that the installation stage has been completed” as disclosed in column 4 lines 16-21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to for the subscriber identity module (SIM) contains a temporary memory area for temporarily storing a further identity which is calculated or communicated by the mobile switching center, since it has been held that

rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Arguments

3. Applicant's arguments filed 4/27/04 have been fully considered but they are not persuasive.

Regarding the applicants arguments concerning the subscriber identification number is not the same as the IMSI, the examiner contends that the similarities between them are that both are used as a source of user identification, the applicant is referred to the above rejection.

The examiner contends that the Garcia Aguilera et al. reference teaches that it is well known in the art that applying a calculation rule will create or produce a new identification number.

The examiner further contends that the Garcia Aguilera et al. reference discloses that with the rearranging parts being the (TCF of the Garcia Aguilera et al. reference) performs the calculation rule instead of the SIM performing the calculation rule to generate a new identification would have been obvious to one of ordinary skill in the art and involves only routine skill in the art, the applicant is referred to the above rejection.

The examiner stands by and restates the above rejection.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (703)305-0104. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

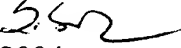
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Application/Control Number: 09/485,679

Page 7

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Smith. 
July 11, 2004


EBC
Patent Center
Patent Center